

Remarks

Claims 52-54 and 66 are amended, and claims 67-68 are added. Claims 52-68 are now pending in this application. The amendments to the claims are supported by the application as filed, and no new matter has been added.

The amendments to claims 52-54 are supported by the specification as filed, for example, at page 10, lines 13-16.

Amended claim 66 is supported by originally filed claim 32.

New claims 67-68 are supported by the specification as filed, for example, at page 15, lines 14-17.

Applicant submitted an Information Disclosure Statement and Form 1449 on October 24, 2003. As indicated on the Information Disclosure Statement, pursuant to 37 C.F.R. § 1.98(d), copies of the listed documents were not provided as those documents were previously cited by or submitted to the U.S. Patent Office in connection with Applicant's prior U.S. application, Serial No. 09/590,884, filed on June 09, 2000, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Applicant submits that the October 24, 2003 Information Disclosure Statement and Form 1449 complied with the requirements of 37 C.F.R. § 1.98(d). However, the Examiner was not able to locate the documents listed on the Form 1449 for consideration in the current application. To expedite prosecution, copies of the lined-through documents are included herewith. Applicant respectfully requests that an initialed copy of the Form 1449 from the October 24, 2003 Information Disclosure Statement be returned to Applicant's Representatives to indicate that the cited documents have been considered by the Examiner.

The Examiner objected to the Title and to the Abstract. The Title and Abstract are amended to obviate these objections.

The Examiner objected to the amendment filed on October 24, 2003 under 35 U.S.C. § 132, alleging that it introduces new matter by changing compound "12" to compound "11" in Table 1. Applicant respectfully disagrees. Table 1 is amended to correct a typographical error, *i.e.*, Table 1 is amended to correctly associate the last 3 rows of data in Table 1 with compound "11" not compound "12". The Examiner's attention is respectfully drawn to page 23, line 8 of the specification, which indicates that for Table 1, the art worker should refer to Figure 4 for the identity of the compounds listed in Table 1. Figure 4 depicts structures for compounds identified

as 1-11. Table 1 does not list any results for a compound "11" and Figure 4 does not depict a compound identified as 12. The Examiner is also requested to note that at page 18, lines 21-22, the specification instructs the art worker that "[c]ompounds 1-11 (Figure 4) are readily available from commercial sources."

Thus, Applicant respectfully submits that amending Table 1 to correctly associate the last 3 rows of data with compound "11" and not compound "12" does not introduce new matter. The Examiner is respectfully requested to withdraw the 35 U.S.C. § 132 objection.

The Examiner rejected claims 52-66 under 35 U.S.C. § 112, first paragraph, alleging that those claims fail to comply with the written description requirement. Specifically, the Examiner alleges that the present claims read on a plethora of compounds that are unlikely to work in the claimed invention. As this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

The Examiner is respectfully reminded that the written description requirement may be satisfied through sufficient description of a representative number of species by disclosure of relevant identifying characteristics, *i.e.*, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics sufficient to show the applicant was in possession of the claimed genus. Guidelines for Examination of Patent Applications Under the 35 U.S.C. § 112, (1), "Written Description" Requirement, Fed. Reg. Vol. 66, No. 4, pages 1099-1111, at 1106.

As the Examiner acknowledges at page 3 of the Office Action, the claims are directed to kits containing a compound where the compound is described. Specifically, the pending claims recite that the kits contain an organic compound that has at least one carbon-sulfur single bond (C-S), carbon-sulfur double bond (C=S), carbon-selenium single bond (C-Se), or carbon-selenium double bond (C=Se). The Examiner's attention is also drawn to the specification as filed, for example, to pages 10-15, which provides further description of examples of such organic compounds.

The Examiner is further requested to note that the pending claims recite functional properties for the organic compounds, *e.g.*, claim 52 recites an organic compound in an amount for reducing luminescence that is not dependent on the presence of an analyte by at least about

10 fold and for reducing luminescence that is dependent on the presence of an analyte by less than about 7 fold, claim 53 recites an organic compound in an amount for reducing luminescence generated by luminogenic molecules not bound to an enzyme by at least about 10 fold and for reducing luminescence generated by luminogenic molecules bound to an enzyme by less than about 7 fold, and claim 54 recites an organic compound in an amount for reducing autoluminescence by at least about 10 fold, and for reducing luminescence that is dependent on the presence of an analyte by less than about 7 fold.

As the Examiner acknowledges, Applicant has provided working examples of organic compounds that meet both the structural and functional requirements recited in the claims. Thus, as the claims recite relevant structural and functional characteristics of the organic compounds, Applicant respectfully submits that the written description requirement of 35 U.S.C. § 112, first paragraph has been satisfied.

Accordingly, withdrawal of the § 112(1) "written description" rejection is appropriate and is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

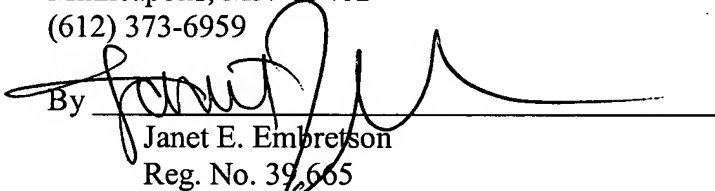
Respectfully submitted,
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Date

June 29, 2005

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of June, 2005.

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Signature